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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/931,590	08/16/2001	Scott G. Newnam	109.779.134	2417
23483 7590 01/24/2007 WILMER CUTLER PICKERING HALE AND DORR LLP 60 STATE STREET BOSTON, MA 02109			EXAMINER ALAM, UZMA	
			ART UNIT	PAPER NUMBER
			2157	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/24/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

09/931,590

Applicant(s)

NEWNAM ET AL.

Examiner

Uzma Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This action is responsive to the arguments filed October 18, 2006. Claims 1-10 and 12-27 are pending. Claims 10, 12-27 represent an interactive storage device storing broadcasted events.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically teachd or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintani et al. US Patent Publication No. 2002/0124249 in view of Schoff et al. US Patent Publication No. 2001/0001160. Shintani et al. teaches the invention as claimed including an interactive distance learning system (see abstract).

As per claims 1 and 13, Shintani et al. teaches a method and system for enhancing content during a broadcast event for remote viewers having a local storage device for storing the broadcast event and playing back the broadcast event, the method comprising:

the local storage device storing the broadcast event as it is being broadcast (a local set top box such as personal video recorder, 0022-0023, 0049);

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a personal interactivity recorder (PIR) receiving and storing interactive content from a server system, the interactive content being related to the broadcast event and the PIR temporally associating the interactive content with the broadcast event (advertisements sent and stored is merged with the broadcasted content; 0026, 0046-0048);

playing back the broadcast event from storage such that when the broadcast event is played back from storage, the PIR provides to the user the interactive content at times during the stored broadcast event when such interactive content would have been displayed when the event was being broadcast (the advertisement is played back with the recorded content in the same place that original ads from the content provider were played; pp 0049-0051).

Shintani does not teach separately from the broadcast of the broadcast event and therefore not embedded in the broadcast event signal. Schoff teaches separately from the broadcast of the broadcast event and therefore not embedded in the broadcast event signal. See paragraphs 0037-0038, 0050-0052, 0066. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the content of Shintani with the separate broadcasting of content of Schoff. A person of ordinary skill in the art would have been motivated to do this to receive content more efficiently.

As per claims 3 and 15, Shintani et al. and Schoff teach the method and system of claims 1 and 13, wherein the temporal associating includes using one or more of absolute time codes, relative time codes, and frame sequence numbers (Shintani pp 0054-0055).

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As per claims 4 and 16 and 17, Shintani et al. teaches the method and system of claims 1 and 13 wherein the PIR has two way communication with the head end system (pp 0032).

Shintani does not teach wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question.

Schoff teaches wherein the interactive content includes trivia questions, the user has an input device for entering an answer, and the PIR stores the correct answer and provides to the user an indication of a correct or incorrect answer after the user enters an answer to a question. See paragraph 0032, 0035, 0074.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the interactivity of Schoff with the two way communication of Shintani. A person of ordinary skill in the art would have been motivated to do this to enhance the client's viewing ability and provide personal services to the user (Shintani pp 0032-0034).

As per claims 5 and 18, Shintani et al. teaches the method of claims 1 and 13, wherein the PIR has two way communication with the head end system (pp 0032). Shintani does not teach wherein interactive content includes poll questions, the PIR storing poll results, the user has an input device for entering a response, and the PIR provides poll results after the user enters a response to the poll question. Schoff teaches wherein interactive content includes poll questions, the PIR storing poll results, the user has an input device for entering a response, and the PIR provides poll results after the user enters a response to the poll question. See paragraph 0032, 0035, 0074.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the interactivity of Schoff with the two way communication of Shintani. A person of ordinary skill in the art would have been motivated to do this to enhance the client's viewing ability and provide personal services to the user (Shintani pp 0032-0034).

As per claims 6 and 19, Shintani et al. and Schoff teach the method of claim 1, wherein the interactive content and video broadcast event are stored on the same medium (Shintani pp 0022, 0023, 0049).

As per claim 7, Shintani et al. and Schoff teach the method of claim 1, wherein the PIR uses the processing and storing functionality of the local storage device (Shintani pp 0022-0023, 0049).

As per claim 8, Shintani et al. and Schoff teach the method of claim 7, wherein the local storage device includes a hard drive (Shintani pp 0022-0023, 0049).

As per claim 9, Shintani et al. and Schoff teach the method of claim 1, wherein the local storage device includes a hard drive (Shintani pp 0022-0023, 0049).

As per claim 11, Shintani et al. and Schoff teach the method of claim 1, where in the broadcast event and interactive content are sent over different channels of transmission (Shintani pp 0026, pp 0050).

As per claim 12, Shintani et al. and Schoff teach the method of claim 1, wherein the PIR includes processing and storage (Shintani pp 0022-0023, 0049).

As per claims 20 and 24, Shintani et al. and Schoff teach the method and system of claims 1 and 13, wherein the broadcast is received from a head-end facility separate from the server system (Shintani pp 0026, pp 0049-0050).

As per claims 21 and 25, Shintani et al. and Schoff teach the method and system of claims 1 and 13, wherein, during playback, the server system interacts with the user such that the user receives responses from the server in response to input from the user (Shintani pp 0049-0051).

As per claims 22 and 26, Shintani et al. teaches the method of claims 21 and 25 wherein the PIR has two way communication with the head end system (pp 0032). Shintani does not teach wherein the user receives a prompt to enter a poll response and the server system is responsive to the poll response when the poll response is entered at a time other than during the line broadcast. Schoff teaches wherein the user receives a prompt to enter a poll response and the server system is responsive to the poll response when the poll response is entered at a time other than during the line broadcast. See paragraph 0032, 0035, 0074.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the interactivity of Schoff with the two way communication of Shintani. A

person of ordinary skill in the art would have been motivated to do this to enhance the client's viewing ability and provide personal services to the user (Shintani pp 0032-0034).

As per claims 23 and 7, Shintani et al. and Schoff teach the method of claims 1 and 13, wherein the PIR receives programming by downloading or flashing (Shintani pp 0022-0023, pp 0049-0050).

Claims 2 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shintani et al. et al. in view of Schoff et al. US Patent Publication No. 2001/0001160 and in further view of Dunn et al. US Patent No. 5,517,257. Shintani et al. and Schoff teach the method and system of claims 1 and 13 including the PIR having the functionality of a VCR and set top box. See claims paragraphs 0022-0023 and 0050. Shintani et al. and Schoff do not expressly teach wherein the local storage device includes functionality for fast forward, rewind, and pause functions. Dunn teaches the local storage device includes functionally for fast forward, rewind, and pause functions. See column 5, lines 39-60. However, the concept and advantages of fast forward, rewind and pause functions is old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the VCR and set top box function of Shintani et al. and Schoff with fast forward, rewind and pause functions. A person of ordinary skill in the art would have been motivated to do this to allow the user to view the event conveniently.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shintani et al. et al. in view of Schoff et al. US Patent Publication No. 2001/0001160 and in further view of Bolnick et al. US Patent Publication No. 2002/0023230.

Shintani et al. teaches the method of claim 1. Shintani et al. does not teach wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. Bolnick teaches wherein the PIR stores and plays back messages sent by other viewers using a chat functionality during the broadcast event. See paragraph 0034 and claim 12. It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the chat functionality of Bolnick with the broadcast event of Harper. A person of ordinary skill in the art would have been motivated to do this to enhance the interactivity of the session.

Response to Arguments

1. Applicant's arguments with respect to claims 1-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uzma Alam whose telephone number is (571) 272-3995. The examiner can normally be reached on Monday-Tuesday 5:30 AM- 2:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uzma Alam

Ua

January 16, 2007


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